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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/035,890      | 12/31/2001  | Douglas A. Nagan     | DUNHAM              | 4256             |

8933 7590 04/09/2007  
 DUANE MORRIS, LLP  
 IP DEPARTMENT  
 30 SOUTH 17TH STREET  
 PHILADELPHIA, PA 19103-4196

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| EXAMINER |
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HAMILTON, LALITA M

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3691

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 04/09/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/035,890

Applicant(s)

NAGAN ET AL.

Examiner

Lalita M. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Summary

On November 3, 2006, an Office Action was sent to the Applicant rejecting claims 1-10. On January 2, 2007, the Applicant responded with arguments.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoltz (2003/0125997).

Stoltz discloses a method for risk assessment comprising creating a questionnaire containing a series of questions for prompting a user to supply information segmented according to risk areas, wherein the risk areas encompass categories of potential losses including legal and technological exposures in business practice, operational procedures, historical experience, compliance with regulations, and external threats including infrastructure failures and third party actions, providing a data store for recording data identifying user responses to the questions; programming a series of scoring rules containing an algorithm whereby the user responses are interpreted as indicating a predetermined level of risk at least as to categories of said

potential losses and exposures, presenting the questionnaire to a user and collecting the user responses in the data store, processing the user responses through the scoring rules and the algorithm to generate a report identifying risk levels according to the risk areas (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); storing a series of recommendations associated with the risk areas, selecting among the recommendations as a function of at least one of the user responses and the risk levels identified by said processing step, and presenting selected ones of the recommendations in the report (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); creating a database and storing the questions and the user responses for a plurality of users for comparison in risk assessments of future users (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); one of segmenting of the risk areas, creating the questionnaire and composing the algorithm comprises reliance on available data and judgment of professionals skilled in the risk areas (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); the risks comprise at least one of risk of potential loss or exposure due to computational deficiency, denial of service, security breach, violation of legal regulations, violation of established law, tortious conduct, contractual breach, insufficient capacity to meet contractual obligations, breach of commitment of confidentiality, violation of intellectual property rights, and failure to adhere to multi-jurisdictional differences in regulations (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); the risks are selected from the group consisting of risk of potential loss or exposure due to computational deficiency, denial of service, security breach, violation of legal regulations, violation of established law, tortious

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conduct, contractual breach, insufficient capacity to meet contractual obligations, breach of commitment of confidentiality, violation of intellectual property rights, and failure to adhere to multi-jurisdictional differences in regulations (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); the risks consist of risk of potential a-claim loss or exposure due to computational deficiency, denial of service, security breach, violation of legal regulations, violation of established law, tortious conduct, contractual breach, insufficient capacity to meet contractual obligations, breach of commitment of confidentiality, violation of intellectual property rights, and failure to adhere to multi-jurisdictional differences in regulations (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); questionnaire requires selection among a limited set of possible answers and the algorithm quantifies risk based on each possible answer (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); the questionnaire requires selection among yes/no and numeric answers (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105); and the questionnaire permits at least one of a missing answer and an answer indicating a lack of information, and wherein the algorithm assesses the risk levels as a function of said one of a missing answer and said lack of information (p.1, 11 to p.2, 17; p.2, 28 to p.3, 52; p.4, 54; and p.5, 67 to 9.6, 105).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.


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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**LALITA M. HAMILTON**  
**PRIMARY EXAMINER**